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In re Application of BECKER et al.
Application No.: 10/532,393
PCT No.: PCT/EP03/10470
Int. Filing: 19 September 2003
Priority Date: None
Attorney Docket No.: 6097P063
For: BEARING HOUSING

: DECISION ON PETITION
: UNDER 37 CFR 1.47(a)
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This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 07 June 2007 to accept the application without the signature of joint inventor Nicolas Delucis. Petitioner also filed a petition to revive the unintentionally abandoned application.

BACKGROUND

On 21 April 2005, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 01 June 2006, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required. Applicant was advised that the time period within which to reply was within two (2) months of mail date of the notification. The extensions of time were available under 37 CFR 1.136(a).

On 01 December 2006, the application went abandoned for failure to reply to the 905.

On 07 June 2007, applicant filed the instant petition along with a petition to revive and a declaration, executed by the joint inventors on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor Nicolas Delucis alleging that Mr Delucis refuses or is unavailable to sign.

DISCUSSION

Petition under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper response unless it has been previously submitted, (2) the fee required by law for revival of an unintentionally abandoned application (1.17(m)), (3) a statement that the "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional", and (4) any terminal disclaimer (and fee as set forth in 1.20(d))

required pursuant to 37 CFR 1.137(d). Applicant has satisfied Items (1)-(3) with the submission of the petition. Item (4) is not applicable to this application. The petition to revive 10/532,393 is **GRANTED**.

Petition under 37 CFR 1.47(a)

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

The petition included the requisite petition fee, satisfying Item (1). Item (3) is satisfied because the last known addresses of non-signing inventor was provided.

With regard to item (4), the declaration executed by the available joint inventors on their behalf and on behalf of the non-signing inventor was submitted. However, the declaration was altered by Markus Becker.

Section 602.01 of the MPEP states the following:

The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required....

Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether non-initialed and/or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration.

The changes made in the declaration executed by inventor Becker were not dated and initialed or signed. Therefore, a new acceptable oath or declaration executed by Markus Becker is required to satisfy the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States. Item (4) is not yet satisfied.

Inventors' Refusal to Sign

With respect to Item (2) above, a statement of first hand knowledge by Michael Mallie, attorney for the above named law firm, was attached to the petition, detailing the efforts made to obtain the nonsigning inventor's signature. Mr. Mallie related several attempts to mail a copy of the "declaration" to the nonsigning inventor without success. However, a copy of the complete application including specification, claims and drawings and declaration, must be sent to the nonsigning inventor. Mr. Mallie sent only a copy of the declaration. Where applicant is attempting to demonstrate that Mr. Delucis is refusing to sign the application, the nonsigning inventor must be presented with a complete copy of all of the national stage application papers (specification, including claims and drawings, oath or declaration) for this application.¹ It is important that the inventor be presented with a copy of the application papers to ensure that the

¹ Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.

inventor is apprised of the application to which the declaration is directed. Furthermore, Petitioner has not provided any proof that delivery to Mr. Delucis occurred. Such proof is necessary to conclude that the nonsigning inventor is refusing to sign the application. See Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal.²

Unavailability of Inventor

Mr. Mallie states that on 08 November 2006, Federal Express contacted him indicating that Mr. Delucis moved from the address provided and that there was no forwarding information. Thus, it appears that Petitioner may be unable to find or reach Mr. Delucis.

With respect to counsel's inability to find or reach Mr. Delucis, Petitioner must demonstrate what "diligent efforts" were undertaken by counsel to locate him and obtain his signature on the declaration. Mr. Mallie states that the copy of the declaration was sent to Mr. Delucis and returned by the postal service as undeliverable. Further efforts to locate the nonsigning inventor must be attempted and detailed in a first hand statement of facts. Such statement by the person with first hand knowledge, which fully describes the exact facts relied on to establish that a diligent effort was made, is required.

As indicated in the MPEP Section 409.03(d), where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the

² A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, diligent efforts made to locate the nonsigning inventors were not pursued and documented such as Internet searches, contact with the joint inventors to obtain Mr. Delucis' current address, current email address and/or current employer. No attempt to reach the nonsigning inventor by telephone was made. No request from the Postal Service for his forwarding address was made. Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a "diligent effort" was made. Petitioner's statement of facts under 37 CFR 1.47(a) does not indicate that any search for Mr. Delucis' new address was made. Since no attempts to locate inventor Delucis were documented, it can not be concluded that "a diligent effort" was made to locate the non-signing inventor.

The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. Under these circumstances, it cannot be concluded that the nonsigning inventors are unavailable to sign the application.

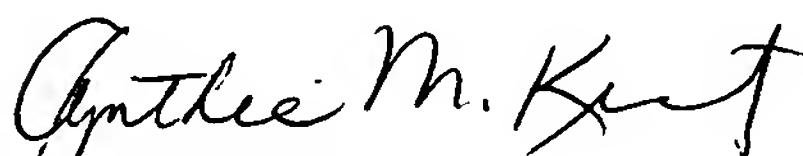
In sum, Petitioner has satisfied Items (1), and (3) above. Item (4) is not yet satisfied as a newly executed declaration by Markus Becker is required. Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/532,393 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and Nicholas Delucis' refusal to sign these documents and (2) that "a diligent effort" was made to contact nonsigning inventor Delucis. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.137(b) is GRANTED; the petition under 37 CFR §1.47(a) is DISMISSED WITHOUT PREJUDICE.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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